

REMARKS

Claims 1, 2, 4, 5, and 8-12 are pending in the application. Claims 1, 2, 5, 8, 9 and 11 are sought to be amended without prejudice thereto or disclaimer thereof any subject matter omitted. Claims 3, 6 and 7 are sought to be cancelled without prejudice thereto or disclaimer thereof any subject matter contained therein. Claim 1 has been amended to recite "a signal sequence within the C protein." Support for this amendment can be found in Applicants' specification, for example, at page 3, line 17 to page 4, line 10. Support for recitation of "post translational" in Claim 1 can be found in Applicants' specification, for example, at page 3, lines 20-26. Claim 5 has been amended to recite "amino acid positions 201-243 of the BVDV polyprotein." Support for this change can be found in Applicants' specification, for example, at page 3, lines 20-22; and at at page 7, lines 31-33, and in Fig. 1. Claim 9 has been amended to remove its multiply dependent format. The application has been amended in response to various objections. Applicants respectfully assert that none of these amendments introduces new matter.

Priority

Applicants respectfully request that the Examiner reconsider and withdraw the objection pertaining to the priority statement, which has been amended as shown above.

Specification

Applicants respectfully request that the Examiner reconsider and withdraw the objection pertaining to the abstract, which has been amended and provided on a separate sheet herewith.

Claim Objections

Applicants respectfully request that the Examiner reconsider and withdraw the objection pertaining to claims 1 and 9, which have been amended as shown above.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-8 and 12 are rejected under 35 U.S.C. §112, second paragraph for allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action, page 3.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection pertaining to these claims, as claims 1, 5 and 8 have been amended as shown above.

Claim Rejections Under 35 U.S.C. §102(b)

Moorman et al. (U.S. 6,180,109)

Claims 1, 2, 6, 8 and 12 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Moorman *et al.* Office Action, page 4. Applicants respectfully traverse the rejection.

Solely to expedite prosecution and not in acquiescence to the rejection, however, Applicants have amended the claims such that the recited pestivirus replicons are limited to those that are incapable of expressing one or more structural proteins of the virus, characterized in that the replicons express all structural proteins of a pestivirus except for a functional C protein, but wherein the coding sequences encoding a signal sequence of the C protein essential for post translational processing are retained or replaced by a coding sequence encoding analogous signal sequences from another pestiviral species. Accordingly, Applicants believe that this rejection under 35 U.S.C. § 102(b) is moot, and request that it be reconsidered and withdrawn.

Moreover, Moorman *et al.* cannot be used to set forth an obviousness rejection of the claims under 35 U.S.C. § 103. The M.P.E.P. states that among other requirements

[t]o establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . [T]he prior art reference (or references when combined) must [also] teach or suggest all the claim limitations.

M.P.E.P. 8th ed., §2143 (revised October 2005). Because there is no suggestion or motivation to modify Moorman *et al.* or to combine it with other publications, and because there are no

publications with which it can properly be combined to teach or suggest all of the claim limitations, an obviousness rejection based upon Moorman *et al.* cannot be set forth.

Heinz et al. (U.S. 2004/0052818)

Claims 1-5, 8 and 12 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Heinz *et al.* (U.S. 2004/0052818). Office Action, page 5. Applicants respectfully traverse the rejection.

Applicants' application was filed as a National Phase filing under 35 U.S.C. § 371 off of international application PCT/EP2003/009031, which has an international file date of August 12, 2003. Hence, a publication is not available as prior art under 35 U.S.C. §102(b) against Applicants' claims unless it was published by August 11, 2002.

In contrast, U.S. 2004/0052818 was published on March 18, 2004. This date is after Applicants' international file date. Hence, U.S. 2004/0052818 cannot form the basis of a rejection under 35 U.S.C. § 102(b). Moreover, the publication of the international application to which U.S. 2004/0052818 claims priority (WO 02/066621) cannot form the basis of a rejection under §102(b), as it was not published until August 29, 2002. *See* Exhibit A. Accordingly, Applicants request that the examiner reconsider and withdraw this rejection.

Moreover, U.S. 2004/0052818 (or WO 02/066621) are not available as prior art under 35 U.S.C. §102(a) or (e) against Applicants' claims. These statutes provides as follows (emphasis added):

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

...

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)

shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty *in the English language*;

....

Here, U.S. 2004/0052818 cannot form the basis of a rejection under §102(a) because it was published on March 18, 2004, which is after Applicants' international file date. U.S. 2004/0052818 was also published *after* Applicants' foreign priority date of August 13, 2002. Moreover, WO 02/066621 cannot form the basis of a rejection under §102(a) because it was published on August 29, 2002, which is *after* Applicants' foreign priority date of August 13, 2002.

U.S. 2004/0052818 cannot form the basis of a rejection under §102(e) because the international application from which it stems was filed and published in a non-English language. *See* 35 U.S.C. §102(e) *supra*, and M.P.E.P., 8th ed., §2136.03(II) (Oct. rev., 2005). Here, U.S. 2004/0052818 is a National Phase entry under 35 U.S.C. §371 of International Application PCT/AT02/00046 (published as WO 02/066621). Although International Application PCT/AT02/00046 appears to have an international file date of February 11, 2002, it was not filed or published in the English language. *See* Exhibit A. From USPTO's Public Pair, it appears that this application was first filed in the English language with the USPTO on June 16, 2003 (*i.e.*, the application giving rise to the U.S. 2004/0052818 publication). This date, however, is *after* Applicants' foreign priority date of August 13, 2002. Hence, neither U.S. 2004/0052818 or WO 02/066621 are available as references under 35 U.S.C. §102(e).

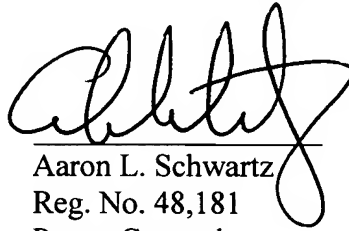
In conclusion, neither U.S. 2004/0052818 or WO 02/066621 are available as prior art under 35 U.S.C. § 102(a), (b) or (e).

USSN: 10/524,210
Attorney Docket: 1-2002.014 US
Response to Office Action of June 20, 2006

Applicants do not believe that any other fee is due in connection with this filing. If, however, Applicants do owe any such fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. 02-2334. In addition, if there is ever any other fee deficiency or overpayment under 37 C.F.R. §1.16 or 1.17 in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. 02-2334.

Applicants submit that this application is in condition for allowance, and request that it be allowed. The Examiner is requested to call the Undersigned if any issues arise that can be addressed over the phone to expedite examination of this application.

Respectfully submitted,



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***Replicons of Pestiviruses that do not Express C and or E1 Protein and Infectious Viral
Particles Containing Same that can be Used in Vaccines***

ABSTRACT

The present invention provides new Pestiviral RNA genomes (replicons) that are able to replicate, and can be packaged into infectious viral particles in cells that complement the missing protein(s), but do not produce infectious progeny virus. Such replicons can be useful for vaccine purposes.

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EXHIBIT A